

REMARKS

Claims 96-143 are pending in the present application. Claims 97-110 and 116-143 have been withdrawn from consideration. By the present Amendment, claims 96 and 111-114 have been amended. This application continues to include claims 96-143.

The drawings were objected to because of informalities. Also, the specification stands objected to because of informalities. The identified informalities are identical to the informalities identified in the Office Action of January 9, 2009, in co-pending continuation application 11/680,942. As such, in the present application, which is the parent of the continuation application 11/680,942, Applicants preemptively addressed these drawing and specification objections in the SECOND PRELIMINARY AMENDMENT dated May 9, 2008, including submission of formal drawings for Figs. 1-21.

However, in co-pending continuation application 11/680,942, in the Office Action mailed September 18, 2008, the Examiner further objected to the specification, and more particularly, to paragraph 0070 and the list of parts. Accordingly, Applicants have preemptively addressed these additional concerns expressed by the Examiner in the continuation application by further amending the specification as set forth herein.

The amendments to the specification do not add new matter.

Accordingly, it is respectfully requested that the objections to the drawings and specification be withdrawn.

Claims 111-115 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 111-114 have been amended for clarification. Support for each of claims 111-115 may be found in the specification, for example, at paragraphs [0070]-[0073] and [0092]-[0093].

Accordingly, it is respectfully requested that the rejection of claims 111-115 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claims 111-115 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 111-114 have been amended for clarification, and to address the Examiner's concerns. Support for each of claims 111-115 may be found in the specification, for example, at paragraphs [0070]-[0073] and [0092]-[0093].

Accordingly, it is respectfully requested that the rejection of claims 111-115 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claim 96 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4989614 (Dejter, Jr. et al.; hereinafter Dejter).

Claim 96, as amended, recites:

A biopsy device for taking tissue samples, comprising: a housing containing an electric power source and a tension slide connected to the power source, wherein the tension slide is brought into a cocked position against the action of a first spring by the power source, the tension slide being locked in the cocked position by a releasable locking mechanism; a removable element configured for insertion into the housing, comprising: a biopsy needle unit, comprising a hollow biopsy needle, having a sample removal chamber, and a cutting sheath, wherein the biopsy needle unit is arranged on the tension slide; a vacuum pressure-generating device; and a connection element connecting the biopsy needle unit and the vacuum pressure-generating device; and a control panel attached to the housing. (Emphasis added).

Support for the amendment of claim 96 may be found in Applicants' specification, for example, at paragraphs [0071]-[0073]. For example, at paragraph [0072] (see also Figs. 9a, 9b, 10a, 10b), it is stated, "The tension slide is locked by the locking of the lever part 99 in the cocked condition and can now be triggered when necessary with the activating button 88."

Turning now to the rejection, it is respectfully submitted that Dejter does not disclose, teach, or suggest a cutting sheath and/or does not disclose, teach or suggest a tension slide that is brought into a cocked position against the action of a first spring by the power source, with the tension slide being locked in the cocked position by a releasable locking mechanism, and thus Dejter does not anticipate or render obvious claim 96.

The Examiner identifies sheath 6 of Dejter has corresponding to the recited cutting sheath. However, the sheath 6 of Dejter is a support for needle 2 and stylet 3, and is not a cutting sheath, i.e., a sheath that cuts, nor is Dejter sheath 6 used in any manner to sever tissue. Sheath 6 includes a finger guard 13, or a sheath handle 14, to assist the operator in manipulating the tip of the sheath. (Dejter col. 8, ll. 56-66). In addition, the cutting/collection of cells occurs by the reciprocation of the needle 2 within a target area, with only the aid of vacuum (see, e.g., Dejter col. 7, ll. 26-46). Thus, Dejter does not disclose, teach or suggest a cutting sheath, as recited in claim 96.

Further, while Dejter discloses a mechanism by which the needle is reciprocated, it is respectfully submitted that such does not constitute “a tension slide connected to the power source, wherein the tension slide is brought into a cocked position against the action of a first spring by the power source, the tension slide being locked in the cocked position by a releasable locking mechanism”, as set forth in claim 96 as amended. The term “cocked” in the present specification refers to a locking of the tension slide. (See Applicants’ specification at paragraph [0072]). In contrast, assuming arguendo that Dejter discloses a tension slide, there is no locking/cocking of the slide against the action of a spring, but rather Dejter discloses a reciprocation by the activation and deactivation of the solenoid 70. (See, e.g., Dejter col. 14, ll. 33-38).

Thus, it is respectfully submitted that claim 96 is not anticipated or rendered obvious by Dejter.

Accordingly, it is respectfully requested that the rejection of claim 96 under 35 U.S.C. §102(b) as being anticipated by Dejter, be withdrawn.

Claim 96 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 45, 49, 91, and 94 of co-pending application 11/680,882 in view of Dejter. As an administrative expedient to remove the present provisional rejection, enclosed herewith is a Terminal Disclaimer with respect to co-pending application 11/680,882.

Accordingly, it is respectfully requested that the provisional nonstatutory obviousness-type double patenting rejection of claim 96 be withdrawn.

For at least the reasons set forth above, the present application is believed to be in condition for allowance in its present form, and it is respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 50-5242, RONALD K. AUST, P.C.

Should any questions concerning the foregoing arise, the Examiner is invited to contact the undersigned at (317) 894-0801.

Respectfully submitted,

/Ronald K. Aust, Reg. No. 36735/

Ronald K. Aust
Registration No. 36,735
Attorney for Applicants

RKA/ts

RONALD K. AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0803

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